

REMARKS

The Examiner is thanked for the examination of the application. In view of the remarks that follow, the Examiner is respectfully requested to reconsider and withdraw the outstanding rejections.

Claims 17, 24 – 26, 30, and 44 have been rejected as allegedly directed to nonstatutory subject matter. In response thereto, claim 17 has been amended to tie the claim to a machine, i.e., a scanner.

Claims 1, 3 - 9, 11 – 15, 17 – 34, and 42-47 have been rejected under 35 USC § 112, second paragraph. The Office Action alleges that the specification discloses multiple steps that could be covered by certain elements of the claims. Specifically, the Office Action alleges that it is not clear which portions of the specification relate to the “means for detecting a user selection” in claim 1. The Office Action refers to step 101, step 102, the step before 101, and step 103.

The complete language of the “means” step includes “means for detecting a user selection of a plurality of document blocks that is marked by the user by scanning a document on which the user has marked the plurality of document blocks”.

According to the specification, step 101 includes executing a pre-scan and the pre-scan image data are input to the mark detecting section 171. See paragraph [0057] of the published application, U.S. 2002/0028020. The mark detecting section 171 detects the line 12. See Figure 4 and paragraph [0058]. Although the claims are not limited to the preferred disclosed embodiments, the Examiner is advised that the line 12 relates to the user selection, and the “means for detecting a user selection” of claim 1 relates to the scanning process in which the line 12 is detected.

Step 102 is a step for determining whether or not the mark, e.g., line 12, has been detected. Step 102 does not relate to detecting the mark itself. Step 103 is a process that is executed if it is determined that the mark was not detected in step 102. Thus, step 103 also does not relate to detecting the mark.

Thus, with regard to steps 101, 102, and 103, it should be clear that the “means for detecting a user selection” relates to step 101 – at least in the disclosed embodiment. However, as set forth above, the claims are not limited to the preferred disclosed embodiments.

It is not clear what step is intended by the Office Action’s reference to the step before step 101. However, if that step refers to the user placing a mark on the document, such step is not included in “means for detecting a user selection”. The detection of a user selection presumes that the user selection has already been made.

Similar analysis applies to the remaining independent claims.

If the Examiner is of the opinion that additional issues remain concerning 35 USC 112, the Examiner is encouraged to telephone the undersigned so that proper resolution can be promptly reached.

In the event that this paper is not timely filed within the currently set shortened statutory period, Applicants respectfully petition for an appropriate extension of time. The fees for such extension of time may be charged to our Deposit Account No. 02-4800.

In the event that any additional fees are due with this paper, please charge
our Deposit Account No. 02-4800.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

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